



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,460	06/21/2001	Takenori Kohda	JP920000074US1	6937

30355 7590 04/06/2006

DANIEL E. JOHNSON
IBM CORPORATION, ALMADEN RESEARCH CENTER
INTELLECTUAL PROPERTY LAW DEPT. C4TA/J2B
650 HARRY ROAD
SAN JOSE, CA 95120-6099

EXAMINER

BOVEJA, NAMRATA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/887,460	Applicant(s) KOHDA ET AL.	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 01/17/2006.
2. Claims 1-33 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. *Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The newly added claim limitation of "data that are not incorporated into the images" is a negative limitation that renders the claim indefinite, because it is an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. Furthermore, while there is support in the specification that the data generated by the annotation information may be managed separately as external data, the specification does not directly recite this negative limitation. See MPEP § 2173.05(i) and In re Schecter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). Appropriate correction is required.*
4. The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and

bounds of the subject matter that will be protected by the patent grant.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, since the newly added claim limitation of "data that are not incorporated into the images", does not positively recite what is included in the claimed invention. Therefore, as stated, it is unclear what is the Applicant's invention in this case. Appropriate correction is required.

5. *Claims 1, 4, 5, 11, 20, 21, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

*Claims 1, 4, 5, 11, 20, 21, and 33 utilize the term "**annotation**" to mean class, interface, object appearance, and position information (i.e. metadata per se defined as information about data, or more specifically the descriptive information provided in meta tags in an HTML or XML document header about that document per the glossary at <http://www.ispdeal.com/glossary/metadata.html>) while the accepted meaning of the term annotation per the Merriam-Webster Online Dictionary (<http://www.m-w.com/dictionary/annotated>) is to add notes and comments. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term is indefinite because the specification does not clearly redefine the term. Furthermore, the reference to Figure 11 in the specification can be thought to indicate*

Art Unit: 3622

“annotation” to refer to the common definition of term, since the images also include text on those pages, and the text can be the “annotation” according to the common definition. Applicant’s definition of the term annotated information as referring to metadata is used in examination of the application. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4 and 6-23 are rejected under 102(e) as being anticipated by Sitnik (Patent Number 6,160,570 hereinafter Sitnik).

Disclaimer: *Claims 1, 4, 11, 20, and 21 were found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.*

In reference to claims 1 and 11, Sitnik discloses a method and system for advertising using a computer system or network that provides a contents database for recording image contents and an advertising database for recording advertising data, comprising: generating image contents including *images (col. 3 lines 64 to col. 4 lines 34) and advertising frame information (size and location) (col. 2 lines 8-12, 47-52, and 56-61, col. 3 lines 60-67, and col. 5 lines 57 to col. 6 lines 3), wherein the advertising*

frame information includes annotated information (i.e. metadata, information about data) associated with the images (col. 8 lines 35-67), and recording the contents to a contents database; generating advertising data corresponding to the advertising frame information and recording the data to an advertising database (col. 2 lines 8-12, 47-52, and 56-61 and col. 3 lines 60-67); synthesizing and displaying the synthesized contents to a terminal of a contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and lines 44-56).

7. In reference to claims 2 and 12, Sitnik teaches the method and system wherein the generated contents are managed on an object basis (where object basis is interpreted to mean that each image on the television screen for example is an object such as a cereal box on a shelf, a soda can, or a football), and the advertising frame information is associated with a descriptor of each object (col. 4 lines 13-34 and col. 9 lines 48-56).

8. In reference to claims 3 and 13, Sitnik teaches the method and system further comprising: extracting an object from the generated contents, wherein the generated contents are not managed on an object basis (each scene in a program sequence is treated as a whole instead of each image in the scene being treated as an object); and associating the extracted object with corresponding advertising frame information (col. 4 lines 8-13 and col. 9 lines 44-48).

9. *In reference to claim 4, Sitnik teaches the method wherein the annotated information is incorporated into the images themselves (i.e. data packets containing*

alternative advertising may be included in the video data stream) (col. 8 lines 35-38 and lines 55-58).

10. In reference to claims 6 and 15, Sitnik teaches the method and system said synthesizing *component* comprising storing advertising data as contents data of an object associated with the advertising frame information (col. 2 lines 44-55 and col. 5 lines 12-23).

11. In reference to claims 7 and 16, Sitnik teaches the method and system said synthesizing *component* comprising replacing contents data of an object with advertising data (show an advertisement in the middle of a television program at a certain time for example) (col. 5 lines 56 to col. 6 lines 3, col. 4 lines 8-13, and col. 9 lines 44-48).

12. In reference to claims 8 and 17, Sitnik teaches the method and system said synthesizing *component* comprising superimposing advertising data onto contents data of an object (product placement in a video segment) (col. 2 lines 44-65, col. 4 lines 13-34, col. 5 lines 46-50, and col. 9 lines 21-24, and 48-56).

13. In reference to claims 9 and 19, Sitnik teaches the method said synthesizing comprising: delivering pre-synthesized contents data and the advertising data to a contents user separately; and *component* synthesizing the pre-synthesized data and the advertising data at a terminal system of the contents user (locally) (col. 2 lines 44-55, col. 4 lines 31 to col. 7 lines 40, and Figure 2).

14. In reference to claim 10 and 18, Sitnik teaches the method said synthesizing comprising *component* synthesizing the generated contents before the generated

Art Unit: 3622

contents are delivered to a contents user and in a delivery source (transmitter for example) (col. 2 lines 5-17 and lines 56-65, col. 3 lines 35 to col. 4 lines 7, and Figure 1).

15. In reference to claim 14, Sitnik teaches the method and system wherein the object is an image object of a static image (i.e. a logo) (col. 4 lines 23-27 and col. 9 lines 48-53), a moving image, or an acoustic object (audio data) (col. 4 lines 2-7).

16. In reference to claims 20 and 21, Sitnik teaches a computer-readable recording *medium* embodying a program executable by a computer, the program comprising (software modules) (col. 6 lines 22 to col. 7 lines 40): *code* for delivering and reading image contents *from a contents database, the contents including images (col. 3 lines 64 to col. 4 lines 34) and* advertising frame (size and location) information, *wherein the advertising frame information includes annotated information associated with the images (i.e. metadata, information about data) associated with the images (col. 8 lines 35-67);* *code* for delivering, *presenting*, and reading advertising data corresponding to the advertising frame information to the contents user (col. 2 lines 8-12, 47-52, and 56-61, col. 3 lines 60-67, and col. 7 lines 29-40); *code* for synthesizing and presenting the contents and the advertising data to the contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and 44-56, and col. 7 lines 29-40).

17. In reference to claims 22, Sitnik teaches the computer-readable recording *medium* wherein the program further comprises *code* for extracting an object from the contents, the contents not being managed on an object basis, and associating the

Art Unit: 3622

extracted object with the advertising frame information (col. 4 lines 8-13, col. 7 lines 29-40, and col. 9 lines 44-48).

18. In reference to claims 23, Sitnik teaches the computer-readable recording *medium* wherein the program further comprises *code* for associating a descriptor of an object the contents with the advertising frame information, in which the contents are managed on an object basis (col. 4 lines 13-34, col. 7 lines 29-40, and col. 9 lines 48-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. **Disclaimer:** *Claim 5 was found to be deficient under U.S.C. 112*

second and first paragraph. To the extent the claimed invention was understood, the following art was applied.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sitnik.

In reference to claim 5, Sitnik teaches the method wherein the annotated information is incorporated into the images themselves (i.e. metadata, information about data) associated with the images (col. 8 lines 35-67). Sitnik is however silent about managing this annotated information separately and not including it into the images themselves. It would have been obvious to one having ordinary skill in the art at the

time the invention was made to managing this annotated information separately and not including it into the images themselves as an obvious matter of design choice. Since this information is required to determine information about data, if it is sent with the image, the display settings would be determined at that time based on the specified information, but if it is sent before the image is sent, then the display settings could be in place prior to the arrival of the image for quick formatting and display.

20. Claims 24-33 are rejected under U.S.C. 103(a) as being unpatentable over Sitnik in view of Brown (Patent Number 6,023,686 hereinafter Brown).

In reference to claims 24, 29, and 31, Sitnik teaches an advertising frame associated with an object *that includes* image contents (col. 3 lines 60 to col. 4 lines 34, col. 5 lines 51-53, and col. 9 lines 44-56). Sitnik is silent about a transaction method, system, and a computer-readable recording media comprising: presenting sales information of the advertising frame using a computer or computer system; *to an applicant, who wants to place an advertisement after referring to the sales information, and who offers to purchase the advertising frame; and when an agreement regarding the advertising frame is transacted, communicating information related to the advertising frame to the applicant who has purchased the advertising frame.*

Brown teaches a transaction method, system, and a computer-readable recording media comprising: presenting sales information of the advertising frame (anything that the user wants to purchase i.e. a property *or a service* for example) using a computer or computer system (col. 3 lines 29-38, col. 6 lines 6-11, lines 60-col. 7 line 1, col. 8 lines 35-41, and Figures 1, 6, and 7); *to an applicant, who wants to place an*

advertisement after referring to the sales information, and who offers to purchase the advertising frame (col. 7 lines 46 to col. 8 lines 13, and Figures 6 and 9); and when an agreement regarding the advertising frame is transacted, communicating information related to the advertising frame to the applicant who has purchased the advertising frame (col. 8 lines 42-61 and Figure 10).

It would have been obvious to modify Sitnik to include a transaction method, system, and computer-readable recording media to enable advertisers a way to carry out the purchase of advertisement frames via a computer system. Furthermore, providing the means to carry out the transaction of purchasing advertisement frames online would enable customers to conduct transactions on a global basis.

21. In reference to claim 25, Sitnik teaches producing advertising data corresponding to the advertising frame information (col. 2 lines 8-12, 47-52, and 56-61 and col. 3 lines 60-67); synthesizing and presenting the contents and the advertising data to a contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and lines 44-56).

Sitnik does not teach the transaction method for purchasing advertisement frames via a computer system. Brown teaches the transaction method to carry out a purchase via a computer system (col. 3 lines 29-38, col. 6 lines 6-11, col. 6 lines 60-col. 7 line 1, col. 7 lines 46 to col. 8 lines 13, col. 8 lines 35-61, and Figures 1, 6, 7, 9, and 10). It would have been obvious to modify Sitnik to include a transaction method to enable advertisers a way to carry out the purchase of advertisement frames via a computer system. Furthermore, providing the means to carry out the transaction of

purchasing advertisement frames online would enable customers to conduct transactions on a global basis.

22. In reference to claim 26, Sitnik does not teach the transaction method wherein said presenting sales information is performed by a system provider upon request of an owner of the contents or an owner of the advertising frame, and the delivery of the contents and the advertising data is performed by the system provider. Brown teaches the transaction method wherein said presenting sales information is performed by a system provider (using the central computer system) upon request of an owner of the contents or an owner of the advertising frame, and the delivery of the contents and the advertising data is performed by the system provider (col. 3 lines 29-38, col. 6 lines 6-11, lines 60-col. 7 line 1, col. 8 lines 35-61, and Figures 1, 6, 7, and 10). It would have been obvious to modify Sitnik to include a transaction method in which a system provider presents sales information in order to enable the advertisement frame purchaser to view to the transaction cost online before making a purchase.

Furthermore, providing the means to carry out the transaction of purchasing advertisement frames online would enable customers to conduct transactions on a global basis.

23. In reference to claim 27, Sitnik teaches the method wherein the system provider acquires the contents from an owner of the contents or an owner of the advertising frame (col. 2 lines 8-12, 47-52, and 56-61, col. 3 lines 60-67, and col. 5 lines 57 to col. 6 lines 3), and acquires the advertising data from a purchaser of the advertising frame (col. 2 lines 8-12, 47-52, and 56-61 and col. 3 lines 60-67), the method further

comprising: synthesizing the contents and the advertising data and then delivering the synthesized contents to the contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and lines 44-56).

Sitnik does not teach the transaction method for purchasing advertisement frames via a computer system. Brown teaches the transaction method to carry out a purchase via a computer system (col. 3 lines 29-38, col. 6 lines 6-11, col. 6 lines 60-col. 7 line 1, col. 7 lines 46 to col. 8 lines 13, col. 8 lines 35-61, and Figures 1, 6, 7, 9, and 10). It would have been obvious to modify Sitnik to include a transaction method to enable advertisers a way to carry out the purchase of advertisement frames via a computer system. Furthermore, providing the means to carry out the transaction of purchasing advertisement frames online would enable customers to conduct transactions on a global basis.

24. In reference to claim 28, Sitnik teaches the transaction method wherein the system provider acquires the contents from an owner of the contents or an owner of the advertising frame (col. 2 lines 8-12, 47-52, and 56-61, col. 3 lines 60-67, and col. 5 lines 57 to col. 6 lines 3), and acquires the advertising data from a purchaser of the advertising frame (col. 2 lines 8-12, 47-52, and 56-61 and col. 3 lines 60-67), the method further comprising delivering contents data associated with the advertising frame information and the advertising data separately (not pre-superimposed) to the contents user (col. 44-55, col. 8 lines 35 to col. 9 lines 43).

Sitnik does not teach the transaction method for purchasing advertisement frames via a computer system. Brown teaches the transaction method to carry out a

purchase via a computer system (col. 3 lines 29-38, col. 6 lines 6-11, col. 6 lines 60-col. 7 line 1, col. 7 lines 46 to col. 8 lines 13, col. 8 lines 35-61, and Figures 1, 6, 7, 9, and 10). It would have been obvious to modify Sitnik to include a transaction method to enable advertisers a way to carry out the purchase of advertisement frames via a computer system. Furthermore, providing the means to carry out the transaction of purchasing advertisement frames online would enable customers to conduct transactions on a global basis.

25. In reference to claim 30, Sitnik teaches a *computer component* for synthesizing and presenting the contents and the advertising data corresponding to the advertising frame information (for a particular frame length and size for example) to a contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and lines 44-56).

26. In reference to claim 32, Sitnik teaches the *recording medium* program further comprising: *code* for synthesizing the contents and advertising data and *code* for presenting the synthesized contents to a contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and 44-56, and col. 7 lines 29-40).

27. **Disclaimer:** *Claim 33 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.*

In reference to claim 33, Sitnik teaches the method wherein the image contents include images (col. 3 lines 64 to col. 4 lines 34) and the advertising frame information

includes annotated information associated with the images (*i.e. metadata, information about data*) associated with the images (col. 8 lines 35-67).

Response to Arguments

28. After careful review of Applicant's remarks/arguments filed on 01/17/2006, the Applicant's arguments with respect to claims 1-33 have been fully considered but are not persuasive. Amendments to the claims have both been entered and considered.

29. In reference to claims 1-23, the Applicant argues that the Sitnik reference does not teach the claimed invention, which is now amended to include associated annotated information that is either incorporated into the images or is managed separately as data that are not incorporated into the images as defined on pages 25-27 of the Applicant's specification. The Examiner respectfully disagrees with the Applicant and would like to point to col. 8 lines 35-67 of the Sitnik reference. Specifically, as defined in Applicant's specification on page 25 paragraphs 4 to page 26 paragraphs 1, and in Applicant's remarks, annotation includes object appearance information and object positioning information (*i.e. metadata*). Sitnik teaches the use of metadata which is defined to include information about data, such as information specifying the country in which an image stored in the packet is to be displayed and information indicating that particular images are preferred by males ages 18-49 for example on page 8 lines 35-67. Since this definition was not defined clearly in the specification, if the applicant means for annotated data to refer to information that is control data including screen placement coordinates, scaling and timing for the information, the sizing and other attributes of the data that can be selected with the selected image and can be included in the data

packet for each alternative image that is selected for display, Sitnik teaches this definition of annotated data as well on col. 5 lines 56-col. 6 lines 3 and on Figure 2.

30. In reference to claim 5, the newly added claim limitation of “data that are not incorporated into the images” is a negative limitation that renders the claim indefinite, because it is an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent.

Furthermore, while there is support in the specification that the data generated by the annotation information may be managed separately as external data, the specification does not directly recite this negative limitation. See MPEP § 2173.05(i) and *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). Additionally, as stated, it is unclear what is the Applicant's invention.

The Examiner would also like to point out that while Sitnik does not explicitly state managing annotated information separately as data that are not incorporated in the images, it would have been a matter of obvious design choice to include the annotated data (i.e. metadata, information about data) either in the data packet for each alternative advertisement image as or to send the two as separate data packets, since this information is required to determine information about data, and if it is sent with the image, the display settings would be determined at that time based on the specified information, but if it is sent before the image is sent, then the display settings could be in place prior to the arrival of the image for quick formatting and display.

31. In reference to claims 24-32, Applicant disagrees with the Brown reference.

Applicant argues that the Brown reference is directed to tangible property that cannot be

Art Unit: 3622

reasonably construed to include an advertising slot on a TV program. In response to applicant's argument that the Brown reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Brown reference is related to solving the same problem of making a purchase using a computer. Therefore, the Examiner respectfully disagrees with the Applicant, since the Brown reference is showing something that can be purchased and carrying out that transaction. Furthermore, whether it shows a product or a service (i.e. such as an advertising slot), it is indeed solving the problem of how a user can carry out a purchase.

The Applicant also argues that Brown teaches a bid entry form with a graphical picture of a property to be auctioned and not this is different than presenting the customer dynamic image contents that can be modified to suit the customer's advertising preferences. The Examiner again respectfully disagrees with the Applicant, since the Brown reference is describing something that the user can purchase. Again, whether it is describing a product or service (i.e. such as an advertising slot) that can be purchased by a user, it is clearly focused on describing the object that is being sold to enable the user to carry out a purchase.

Additionally, the purpose of the Brown reference is to show that is well known to make transactions online, so the focus is not meant to be on whether the transaction is

for a product or service, but rather on the fact that online transactions is a well known concept and is something that is frequently utilized in the field of e-commerce to reach a wider range of customer segments in various geographies to particularly extend the reach of the products and services to these customers.

Conclusion

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central**


Art Unit: 3622

FAX phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

April 3rd, 2006



RAFAEL ALVAREZ
PRINCIPAL EXAMINER